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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,949	11/15/2001	Nobuyuki Takamori	70801-56702	5456

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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,949

Applicant(s)

TAKAMORI ET AL.

Examiner

Martin J Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Tajima et al. JP 2000-311381.

Tajima et al. JP 2000-311381 exemplifies optical recording media shown in figures 1,7 and 8, where the UV cured protective layers disclosed in tables 1 and 5. **The example corresponding to the embodiments of table 5 meets the limitations of the claims and use 0.5 mm polycarbonate as the substrate material [0057]. The data in the tables establishes this.**

The examiner notes that the linear expansion coefficients and Young's modulus are relatively unimportant by themselves. As the desire to reduce warping of the media is the intended/desired result, the applicant might find including any limitations found in the specification with respect to the warpage or tilt into the claims to distinguish over less desirable media with high warpage/tilt. (see Inuoue et al. '493)

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4. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Murakami et al. '272.

Murakami et al. '272 teach optical recording media with substrates between 0.5 and 1.2 mm (28/63-65). The example disclosed in column 8 uses a polyurethane-acrylate UV curable resin with a thickness of 5 microns as the overcoating. (8/15-49). The tilt should be less than 10 mrad (21/1)

5. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Inoue et al. '493.

A CD with a resin substrate and a reflective metal film is coated with various UV curable optical recording media. The protective coatings in examples 1-121- through 2-3 use urethane acrylates. Tilt/warp is bad.

Urethane, epoxy, polyester and polyether acrylates are disclosed as useful and meeting the material limitation of the claims in the instant specification on page 11 at lines 1-6.

6. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Ohta et al. '884.

An optical recording medium with a resin substrate and a magneto-optical recording film is coated with a UV cured urethane-acrylate. (3/50-64)

Urethane, epoxy, polyester and polyether acrylates are disclosed as useful and meeting the material limitation of the claims in the instant specification on page 11 at lines 1-6.

7. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Yokoyama '222.

An optical recording medium with a resin substrate and a magneto-optical recording film is coated with a UV cured urethane-acrylate (example 1), and epoxy-acrylate (example 2).

Urethane, epoxy, polyester and polyether acrylates are disclosed as useful and meeting the material limitation of the claims in the instant specification on page 11 at lines 1-6.

8. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Yoshioka et al. '649.

An optical recording medium with a resin substrate and a phase change optical recording film is coated with a UV cured urethane-acrylate. (example 1)

Urethane, epoxy, polyester and polyether acrylates are disclosed as useful and meeting the material limitation of the claims in the instant specification on page 11 at lines 1-6.

9. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Tachibana et al. '709.

An optical recording medium with a resin substrate and a magneto-optical recording film is coated with a UV cured urethane-acrylate. (examples 6 and 7) The warp is less than 10 microns over the diameter of the disk (table 1(col. 13/14))

Urethane, epoxy, polyester and polyether acrylates are disclosed as useful and meeting the material limitation of the claims in the instant specification on page 11 at lines 1-6.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-9 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-9 of copending Application No. 10/002952. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The claims seek coverage for overlapping subject matter

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

12. Claims 1-9 are provisionally rejected under the judicially created doctrine of double patenting over the allowed claims of copending Application No. 09/512253. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The claims seek coverage for overlapping subject matter

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

This application has been allowed and is not available to the examiner


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takagishi et al. '946 teach protective layers while taking the thermal expansion coefficients into consideration.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 703-308-4397. The examiner can normally be reached on Mondays-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J Angebrannndt
Primary Examiner
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September 23, 2003